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10/569,941	02/28/2006	Johann Vastra	1004900-000274	3337
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EXAMINER KEYS, ROSALYND ANN				
ART UNIT 1621		PAPER NUMBER		
NOTIFICATION DATE 08/08/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

### Office Action Summary

**Application No.**

10/569,941

**Applicant(s)**

VASTRA, JOHANN

**Examiner**

ROSALYND KEYS

**Art Unit**

1621

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 December 2007 and 30 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date \_\_\_\_\_
- 6) ☐ Notice of Informal Patent Application
- 7) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1-3 and 5-42 are pending.  
Claims 1-3 and 5-42 are rejected.

### ***Response to Amendment***

#### ***Claim Objections***

2. The objection to claims 6, 7 and 11-34 under 37 CFR 1.75(c) as being in improper form is withdrawn, due to the amendment to said claims, filed April 30, 2008.

#### ***Claim Rejections - 35 USC § 112***

3. The rejection of claims 4, 5, 9 and 10 under 35 U.S.C. 112, second paragraph, as being indefinite is withdrawn, due to the amendment to said claims, filed April 30, 2008.

#### ***Claim Rejections - 35 USC § 102***

4. The rejection of claims 1-5 and 8-10 under 35 U.S.C. 102(b) as being anticipated by Denmark et al. (US 2002/0183516 A1) is withdrawn, due to the amendment, filed April 30, 2008, requiring the siliceous compound carry a transferable group of formula (I).

### ***Specification***

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction

of the following is required: claim 19 discloses that "it being possible for Y3 or Y4 to form, with R4 or R4' and with the atoms to which they are connected, an unsaturated or completely or partially saturated 5- or 6-membered ring". However, the specification does not provide antecedent basis for a completely or partially saturated 5- or 6-membered ring. The specification states a completely or partially unsaturated 5- or 6-membered ring (see lines 4-8 and lines 28-32 of page 27).

#### ***Claim Objections***

6. Claims 5 and 36 objected to because of the following informalities: in claim 5 there is a period after the word "atoms" in line 7; and in claim 36 the solvents dioxane and anisole are listed twice (see lines 2 and 4). Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 9, 10, 21, 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not provide support for the newly added formula in claim 9 nor for R5 being hydrogen as disclosed in claim 21.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 15-17 and 19-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the present instance, claim 15 recites the broad recitation where D is the residue of a cyclic compound, and the claim also recites which preferably has at least 4 atoms in the ring, which is the narrower statement of the range/limitation.

In the present instance, claim 19 recites the broad recitation Z is ..., an alkali metal, and the claim also recites preferably sodium, which is the narrower statement of the range/limitation.

Claims 16, 17 and 20-22 are indefinite because they depend from an indefinite claim. *Ex parte Cordova*, 10 U.S.P.Q.2d 1949, 1952 (P.T.O. Bd. App. 1989).

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 1-3 and 5-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denmark et al. (US 2002/0183516 A1) in view of Dupont et al. (Eur. J. Inorg. Chem., Vol. 2001, Issue 8, August 2001, pages 1917-1927).

Denmark et al. teach a process for creating a carbon-carbon bond by

coupling a transferable group to an acceptor group (see entire disclosure, in particular abstract, paragraphs 0009 to 0136, and paragraphs 0330 to 0338).

Denmark et al. differ from the instant claims in that Denmark et al. transferable group is not a dihalosilane of the formula (I). However, Denmark et al. utilize an analogous process and the skilled artisan would reasonably expect that the use of similar transferable groups would obtain similar results. The skilled artisan would have been further motivated to utilize the process of Denmark et al. to obtain a carbon-carbon bond by coupling a transferable group to an acceptor group since Denmark et al. has already been demonstrated that siliceous compounds similar in structure to the claimed siliceous compound are effective transferable group. A long line of cases have held that the mere use of a different starting material, whether novel or known, in a conventional process to produce the product one would expect therefrom does not render the process unobvious. See for example *In re Surrey et al.* (CCPA 1963) 319 F2d 233, 138 USPQ 67; *In re Larsen* (CCPA 1961) 292 F2d 531, 130 USPQ 209; and *In re Durden, Jr. et al.* (CAFC 1985) 763 F2d 1406, 226 USPQ 359. Further, once the general reaction has been shown to be old, the burden is on the applicant to present reason or authority for believing that a group on the starting compound would take part in or affect the basic reaction and thus alter the nature of the product or the operability of the process. See *In re Neunebauer et al.* (CCPA 1964) 330 F2d 353, 141 USPQ 205 and *In re Boe et al.* (CCPA 1974) 505 F2d 1297, 184 USPQ 38.

Denmark et al. further differ from the claims in that Denmark et al. does not expressly teach the use of the claimed P1 and P2 palladacycles as their palladium

catalyst. However, Denmark et al. do suggest that other palladium catalysts may be used in their invention (see paragraph 0019 and 0075).

Dupont et al. teach and/or suggest palladacycles having the claimed formula P1 and P2 (see entire disclosure pages 1917-1919). It is taught that palladacycles are useful as catalyst for C-C bond forming reactions (see the last paragraph in column 1 of page 1918).

One having ordinary skill in the art at the time the invention was made would have found it obvious to utilize the catalyst of Dupont et al. in the process of or a process similar to the Denmark et al., since Dupont et al. teach that palladacycles are useful as catalyst for C-C bond forming reactions. Further, the claim would have been obvious because "a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense." KSR International Co. v. Teleflex Inc., 550 U.S.\_\_\_\_, 82 USPQ2d 1385, 1395-97 (2007).

### ***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within



TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROSALYND KEYS whose telephone number is (571)272-0639. The examiner can normally be reached on M, R & F 5:30-7:30 am & 1-5 pm; T & W 5:30 am-4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan can be reached on 571-272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ROSALYND KEYS/  
Primary Examiner, Art Unit 1621

August 3, 2008